

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUNE 3, 99
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Areway, Inc.

Serial Nos. 74/612,637; 74/612,683;
and 74/612,639

Donald L. Otto of Renner, Otto, Boisselle & Sklar
for Areway, Inc.

Won T. Oh, Trademark Examining Attorney, Law Office 104
(Sidney Moskowitz, Managing Attorney).

Before Cissel, Wendel and Bucher, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Areway, Inc. has filed applications to register AMI,¹
AREWAY MIRROR IMAGE,² and CLUSTER LUSTER³ for "metal

¹ Serial No. 74/612,637, filed Dec. 19, 1994, claiming first use
dates of Sept. 1, 1994.

² Serial No. 74/612,638, filed Dec. 19, 1994, claiming first use
dates of Sept. 1, 1994.

³ Serial No. 74/612,639, filed Dec. 19, 1994, claiming first use
dates of Sept. 1, 1994.

Ser Nos. 74/612,637; 74/612,638 and 74/612,639

finishing services, namely, buffing and polishing of metals."

Registration has been finally refused in each application on the ground that the specimens of record fail to show use of the designation involved as a mark for the specified services. Applicant and the Examining Attorney have filed briefs in each case, but no oral hearing was requested. In view of the common questions of law and fact which are involved herein, we find it in the interest of judicial economy to consolidate the cases for purposes of final decision. Thus, we have issued this single opinion.

In the specimens of record (which consist of the identical brochure in all three applications), applicant's wheel finishing division is described as "Specialists in Polishing, Buffing and Clearcoating for the Automotive and Track Wheel Industry." The only reference in the brochure to the designations at issue is the following:

Polishing and buffing is offered in the following finishes: AMI [™] (**AREWAY Mirror Image**), Satin finish, color buff, and "Cluster Luster[™]." Any of these polishes can be clearcoated with acrylic according to your customer requirements.

The Examining Attorney takes the position that the specimens show use of AMI, AREWAY MIRROR IMAGE and CLUSTER LUSTER as the names of types of finishes or polishes, and not as marks for the service of buffing and polishing

Ser Nos. 74/612,637; 74/612,638 and 74/612,639

metals. He maintains that the specimens show use of the term "finishes" as a noun, not as a verb, and, thus, that the designations sought to be registered identify a product, not a service. He points to the second sentence, in which the single word "polishes" is used to refer to all of the previously offered "finishes."⁴

Applicant argues that the word "finishes," as used in its specimens, does not mean a product or coating, but rather refers to the method or process used to produce a desired result. Applicant contends that the specimens make it clear that applicant offers the services of polishing, buffing and clearcoating for the automotive and truck wheel industry, and not any products per se. Applicant argues that neither the word "finishes" nor the word "polishes" can be limited to a single meaning, and that there are meanings for both which support applicant's argument that the words refer to applicant's services. For example, applicant points to two dictionary definitions for the noun "finish," as "the way in which the surface, as of

⁴ The Examining Attorney also notes applicant's use of the "TM" symbol, which he contends is suggestive of trademark, rather than service mark, use. We agree with applicant, however, that the use of a "TM" symbol for service marks, as well as trademarks, is widespread and not likely to be interpreted as distinguishing one from the other.

Ser Nos. 74/612,637; 74/612,638 and 74/612,639

furniture, is smoothed, polished, etc.”⁵ and as “the manner in which an object is perfected or finished in its preparation, or an effect imparted in finishing.”⁶ The Examining Attorney, on the other hand, notes other definitions in the same dictionaries for the noun “finish” as “anything used to finish something else, as polish, wax, etc.” and as “a material used for application in finishing.”

To be registrable as a service mark, there must be a direct association between the mark and the services named in the application. In *re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973). Although the Trademark Act does not specifically set forth a definition for a “service,” our principal reviewing court has adopted “the performance of labor for the benefit of another” as an appropriate definition. In *re Advertising & Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987); In *re Canadian Pacific Limited*, 754 F.2d 992, 224 USPQ 971 (Fed. Cir. 1985).⁷ The fact that the applicant is a provider of services is not enough, however. The

⁵ *Webster's New Twentieth Century Dictionary* (1977).

⁶ *Random House Dictionary* (1967).

⁷ TMEP § 1301.01(a)(i) states that for a service to be real, there must be the performance of some activity, either physical or mental action.

Ser Nos. 74/612,637; 74/612,638 and 74/612,639

applicant must show that it has used the mark to identify the named services for which registration is sought. In re Advertising & Marketing Development Inc., *supra*; In re Forbes, 31 USPQ2d 1315 (TTAB 1994).

Here, the only issue is whether the specimens show use of the designations sought to be registered as marks identifying the metal finishing services recited in the applications. From the brochures it is most evident that applicant is in the business of polishing, buffing and clearcoating services to the automotive and track wheel industry. The sole appearance of the designations AMI, AREWAY MIRROR IMAGE and CLUSTER LUSTER in the brochure, however, is in the description of the particular "finishes" which can be obtained as the result of applicant's "polishing and buffing" services.

While applicant and the Examining Attorney have argued over the appropriate meaning of the word "finishes" as used in this context, it is immaterial whether we construe "finishes" as referring to materials used in the process of finishing or to the end results achieved by the process. In either event, the designations sought to be registered are not used in direct association with, or to identify, applicant's metal finishing services. See In re Turbine Metal Technology, Inc., 219 USPQ 1132 (TTAB 1983)[specimens

Ser Nos. 74/612,637; 74/612,638 and 74/612,639

fail to show use of the term TMT-5 as a mark for the services recited in the application]. There is no activity or labor which the designations identify, only the particular appearance which will be obtained as a result of the finishing services. Contrary to applicant's arguments, we cannot equate this result with the services involved in producing the result, just as, for example, we could not equate a "SINISTER BLACK" wall coating with "house painting services."

Accordingly, we find that the specimens of record fail to show use of AMI, AREWAY MIRROR IMAGE or CLUSTER LUSTER as a mark for the metal finishing services specified in the applications.

Decision: The refusal to register is affirmed.

R. F. Cissel

H. R. Wendel

D. E. Bucher
Trademark Administrative Judges,
Trademark Trial and Appeal Board

Ser Nos. 74/612,637; 74/612,638 and 74/612,639